



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,950	07/21/2003	Jason Brown	C02-0109-000	4621
33190	7590	12/12/2006	EXAMINER	
CINGULAR WIRELESS LLC 5565 GLENRIDGE CONN., #1725A C/O LINDA GILES, PATENT MANAGER ATLANTA, GA 30342			TERMANINI, SAMIR	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,950

Applicant(s)

BROWN, JASON

Examiner

Samir Termanini

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communications: Application filed on 7/21/2003.
2. Claims 1-20 are pending. Claims 1, 11, and 19 are in independent form.

CLAIM REJECTIONS - 35 U.S.C. §101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 11-18 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter, and further raises questions as to whether the claims are directed to an abstract idea. More specifically, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts, to be a process, nor are they a combination of chemical compounds to be a composition of matter. The “apparatus” of claims 11-18 appears to be a computer program claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs not limited to those that are “computer-readable” and likewise does not define any structural and functional interrelationship between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. Therefore, claims 11-18, being directed toward computer listings *per se*, fail to fall within a statutory category.

5. For the purposes of examination, claims 11-18 are being examined as if they were directed toward subject matter claimed as embodied on a computer-readable medium.

INFORMATION DISCLOSURE STATEMENT

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the Examiner on form PTO-892, they have not been considered.

CLAIM REJECTIONS - 35 U.S.C. §112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as claimed.

9. More specifically, claim 19 recites "...a display device for presenting text to the apparatus..." (emphasis added). The word 'presenting' appears only twice within the

Art Unit: 2178

entire application - once within paragraph [0009] and once in claim 19. When it appears in paragraph [0009], it is for presenting text to a user. Notwithstanding the permissible shift in Applicant's terminology, from 'displaying' to 'presenting', the application uses, *inter alia*, "display" and "displayed" as terminology to elucidate (and claim) features related to displaying text to users through the display of a communications device. Displaying text on a display of a communications device is well known in the art and the Applicant does not have to provide a disclosure that describes those elements. However, a display device for presenting text to itself, is not; And Applicant must provide a disclosure that describes those elements in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the display device for presenting text to itself.

10. In the interest of advancing prosecution, claim 19 is being examined as if claim 19 was amended to recite "...a display device for presenting text to a user of the apparatus..." as articulated in para. [0009] - the paragraph reciting language most nearly connected to the embodiment being claimed in claim 19.

CLAIM REJECTIONS - 35 U.S.C. §102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

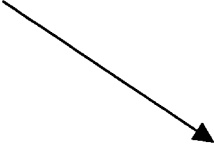
12. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Digital cellular telecommunications system (Phase 2+) (GSM); Universal Mobile*

Art Unit: 2178

Telecommunications System (UMTS); USIM Application Toolkit (USAT); (3GPP TS 31.111 version 4.4.0 Release 4), European Telecommunications Standards Institute 2001 (hereinafter "*ETSUSIM*").

As to independent claim 1, *ETSUSIM* teaches a method, comprising the steps of: controlling a display of a communications device ("DISPLAY TEXT: which displays text or an icon on screen." pp. 21, §6.1) using a Subscriber Identity Module application ("specifically for "USIM Application Toolkit" pp. 10, section 1; Also, USIM means "Universal Subscriber Identity Module" pp. 13, 2nd to last definition); and specifying a duration ("duration of the display" pp. 24, §6.4.1) in the Subscriber Identity Module application for which text is displayed ("A duration object that represents the variable display timeout may be included by the UICC." pp. 24, §6.4.1; See also "Proactive UICC gives a mechanism whereby the UICC can initiate USIM initialization request and notification..." pp. 14; see also "proactive UICC session: sequence of related USAT commands and responses" pp. 12, 6th definition).

As to dependent claims 2, *ETSUSIM* further teaches the step of specifying the duration for which the text is displayed comprises an attribute in the Subscriber Identity Module application ("the SIM/ME interface is the bearer level." pp. 63, before §6.7), the attribute specifying the duration for which the text is displayed ("duration for execution of the command" pp. 52, §6.6.1; see also figure 6.6.1, an annotated version is reproduced immediately below).

Attribute specifying duration 	6.6.1 DISPLAY TEXT				
	Description	Clause	M/O/C	Min	Length
	Proactive UICC command Tag	9.2	M	Y	1
	Length (A+B+C+D+E+F)	-	M	Y	1 or 2
	Command details	8.6	M	Y	A
	Device identities	8.7	M	Y	B
	Text string	8.15	M	Y	C
	Icon identifier	8.31	O	N	D
	Immediate response	8.43	O	N	E
	Duration	8.8	O	N	F

As to dependent claim 3, *ETSUSIM* further teaches the data object for a DISPLAY TEXT (e.g. "interface data object" pp. 63, before §6.7).

As to dependent claim 4, *ETSUSIM* further teaches that the "duration" data object is a parameter in the DISPLAY TEXT command ("A duration object that represents the variable display timeout" pp. 24, §6.4.1).

As to dependent claim 5, *ETSUSIM* further teaches the step of specifying the duration comprises specifying a time for which the text is displayed before clearing the text ("variable display timeout...informs the ME about the required duration of the display" pp. 24, bottom of page).

As to dependent claims 6 and 7, *ETSUSIM* further teaches that the duration comprises specifying the duration for which the text is displayed before either: executing a command to clear the text or until a user clears the text ("indicates that the ME shall wait for the user to clear message" pp. 24, bottom of page).

As to dependent claim 8, *ETSUSIM* further teaches displaying the text until an external event is detected (e.g. "when a higher priority event occurs, e.g. an incoming mobile terminated call." pp. 25, §6.4.1).

As to dependent claim 9, *ETSUSIM* further teaches displaying the text until an internal event is detected (e.g. "the expiration of the variable display timeout, if so indicated by the duration object" pp. 25, §6.4.1).

As to dependent claim 10, *ETSUSIM* further teaches the method according to claim 1, further comprising utilizing a Subscriber Identity Module application toolkit to create the Subscriber Identity Module application ("The present document defines the interface between the Universal ICC (UICC) and the Mobile Equipment (ME), and mandatory ME procedures, specifically for "USIM Application Toolkit" pp. 10, §1; see also "USAT USIM Application Toolkit" pp. 13, before § 3.3).

As to independent claim 11, *ETSUSIM* teaches an apparatus, comprising: a Subscriber Identity Module for use in a communications device ("Mobile Equipment" pp. 139, Annex A), the Subscriber Identity Module storing a Subscriber Identity Module application in memory ("image of USIM EFs in the ME's memory" pp. 40, §6.4.22); wherein the Subscriber Identity Module application specifies a duration for which text is displayed on the communications device ("duration of the display" pp. 24, §6.4.1) .

As to dependent claim 12, *ETSUSIM* further teaches the Subscriber Identity Module application utilizes attribute information (e.g. "the Attribute Information parameter" pp. 131, §8.67) to specify the duration for which the text is displayed ("duration for execution of the command" pp. 52, §6.6.1).

As to dependent claim 13, *ETSUSIM* further teaches that the Subscriber Identity Module application specifies a "duration" data object for a DISPLAY TEXT command (e.g. "interface data object" pp. 63, before §6.7).

As to dependent claim 14, *ETSUSIM* further teaches that the duration specifies a time for which the text is displayed before the text is cleared ("variable display timeout... informs the ME about the required duration of the display" pp. 24, bottom of page).

As to dependent claims 15 and 16, *ETSUSIM* further teaches an apparatus according to claim 11 wherein the duration specifies a time for which the text is displayed before either: executing a command to clear the text or until a user clears the text ("indicates that the ME shall wait for the user to clear message" pp. 24, bottom of page).

As to dependent claims 17 and 18, *ETSUSIM* further teaches Subscriber Identity Module is embodied in a card and plug that interfaces with the communications device ("card defined in GSM 02.17" pp. 146, Annex G: Multiple Card Operation).

As to independent claim 19, *ETSUSIM* teaches an apparatus, comprising: circuitry for at least one of receiving and transmitting signals ("received/transmitted" pp. 62, 3rd para.); a display device for presenting text to a user of the apparatus ("screen", pp. 21, §6.1); a microprocessor for controlling the circuitry and the display device ("execute" and "processing", pp. 12, §3.1); and a Subscriber Identity Module executing a Subscriber Identity Module application stored in memory, the Subscriber Identity Module application ("specifically for "USIM Application Toolkit" pp. 10, section 1; Also, USIM means "Universal Subscriber Identity Module" pp. 13, 2nd to last definition) comprising an attribute specifying a time for which text is displayed on the display device (See "Duration," figure 6.6.1 on pp. 52).

As to dependent claim 20, *ETSUSIM* further teaches that the attribute comprises a "duration" data object in a DISPLAY TEXT command, the "duration" data object specifying

Art Unit: 2178

the time for which the text is displayed on the display device ("A duration object that represents the variable display timeout" pp. 24, §6.4.1).

CONCLUSION

13. Although not relied upon, the following prior art is made of record because it considered pertinent to Applicant's disclosure:

- [1] *Choquet et al.* (US 6178324 B1) for teaching a method of adapting an operation of a subscriber identity module to one or more interfaces of a mobile radio communication terminal and to provide a subscriber identity module that enables the method to be implemented.
- [2] *Hubbe et al.* (US 6667748 B1) for teaching a method of displaying image sequences on mobile radio communications equipment co-operating with a subscriber identity module.
- [3] *Kahan et al.* (US 20020024536 A1) for teaching data items formatted for display according to a mobile terminal subscriber's provisioning profile that are transmitted to the mobile terminal subscriber's terminal for viewing by the subscriber.
- [4] *Background information: Why do we need Variable Timeout* (CR 31.111: T3-010136, T3-010137), Celltick Technologies, 3GPP T3 #18, Sophia Antipolis, France, 1-2 March, 2001.

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Samir Termanini whose telephone number is (571) 270-1047. The Examiner can normally be reached from 9 A.M. to 4 P.M., Monday through Friday (excluding alternating Fridays).

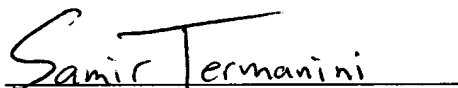
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, *see* <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



STEPHEN HONG
SUPERVISORY PATENT EXAMINER



Samir Termanini
Patent Examiner
Art Unit 2178